Application Number 09/938,144
Response to Final Office Action mailed September 7, 2007

REMARKS

This response is in reply to the Final Office Action dated September 7, 2007. Applicant has added claim 33. Claims 1-6, 16-22, 24-26 and 28-33 are currently pending.

Claim Rejection Under 35 U.S.C. § 112

In the Office Action, the Examiner rejected claim 32 as failing to comply with the written description requirement. Specifically, the Examiner stated that the application as filed fails to disclose the feature of wherein the device is not subservient to a host device. Applicant respectfully disagrees as this feature is clearly disclosed in the application as filed such that one of skill in the art would understand that applicant had possession of the invention.

Mere rephrasing of a passage does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains intact is permissible.[1] In this instance, Applicants specification clearly illustrates of a device according to claim 1 with the characteristic of not being subservient to a host device. For example, as shown in FIG. 4, ISE 402 communicates with a number of components on bus 404, such as mouse 408, monitor 410, MODEM 412 and remote computer 414.[2] One of skill in the art would understand that none of these components are served by ISE 402. For example, the relationship between remote computer 414 and ISE 402 is a peer-to-peer relationship rather than a subservient relationship.[3]

As another example, Applicant's specification discloses with respect to FIG. 3 that ISE 302 may be used with docking station 304, or with a kiosk.[4] In both instances, ISE 302 is not subservient to a host device.

For at least these reasons, claim 32 meets the written description requirement. Applicant requests immediate withdrawal of the rejection of claim 32 under 35 U.S.C. 112.

Claim Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1, 5, 16-19, 22, 24-26, 29 and 30 under 35 U.S.C. 103(a) as being unpatentable over Stefanksy (US 6,226,143) in view of

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[1] *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973), as cited in MPEP 2163.07.
[2] Application, page 9, lines 1-8.
[3] Application, page 9, lines 27-29. *See also*, Application, page 10, lines 8-15.
[4] Application, page 8, lines 26-31.

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Schneider (US 6,363,487). The Examiner also rejected claims 2, 6, 20, 21 and 32 under 35 U.S.C. 103(a) as being unpatentable over Stefanksy in view of Schneider as applied to claims 1 and 18 above, and further in view of Glover (US 6,282,045) and rejected claims 3 and 4 under 35 U.S.C. 103(a) as being unpatentable over Stefanksy in view of Schneider in view of Glover as applied to claim 2 above, and further in view of Durrett (US 5,964,830). The Examiner rejected claim 31 under 35 U.S.C. 103(a) as being unpatentable over Stefanksy in view of Schneider as applied to claim 1 above, and further in view of Durrett and rejected claim 28 under 35 U.S.C. 103(a) as being unpatentable over Stefanksy in view of Schneider as applied to claim 1 above, and further in view of well known in the art.

Applicant respectfully traverses the rejections. The applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

Response to Examiner's New Statements

In the Final Office Action, the Examiner stated that he considered the microcontroller control program as disclosed by Schneider to be equivalent to an operating system as claimed. The Examiner further stated that he considered "tasks including interface for SCSI bus application and interface for AT bus application" to be equivalent to an application program.[5] However, the microcontroller control program itself performs each the tasks cited by the Examiner. Therefore, these tasks cannot logically be considered to be equivalent to a separate application program, as required by Applicant's claims.

Each of claims 1, 16 and 18, recite both an application program and an operating system running the application program. The application program and the operating system as claimed are separate and distinct elements. Because microcontroller control program as disclosed by Schneider performs each of the tasks cited by the Examiner as evidence of an application program, Schneider fails to disclose both an application program and an operating system. As these elements are included in each of the independent claims, Applicant respectfully asserts that the Examiner has failed to provide a prima facie case of obviousness with respect to each of the pending claims.

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[5] Final Office Action mailed September 7, 2007, page 2.

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Claims 1-6, 25, 26 and 30-32

In the rejection of claim 1, the Examiner interpreted microcontroller 224 of Stefanksy as being equivalent to a central processing unit as recited in claim 1. The Examiner further cited Stefanksy, column 8, lines 25-40 as disclosing that microcontroller 224 runs an operating system. For reference, this portion of Stefanksy is reproduced below.

> With reference to FIG. 14, a microcontroller **224** and a minimum number of dedicated control support circuits direct all functions of disk drive **18**. In the preferred embodiments of the present invention, microcontroller **224** is a three megahertz clock rate Motorola MC68HC11 HCMOS single chip microcontroller, as described in the MC68HC11A8 HCMOS Single Chip Microcomputer Technical Data Book (ADI 1207) available from Motorola, Inc., Motorola Literature Distribution, P.O. Box 20912, Phoenix, Ariz., 85036.
>
> A read-only memory (ROM) **226** is coupled to the microcontroller **224** by way of a general purpose data, address and control bus **240**. The ROM **226** is utilized to store a microcontroller control program for supporting five principle tasks necessary to implement the full functionality of the disk drive **18**. These tasks include interface, actuator, spin motor, read/write and monitor.

Applicant notes that the above passage simply illustrates that microcontroller 224, "directs all functions of disk drive 18" apparently through a "microcontroller control program." However, the microcontroller control program in Stefanksy is not equivalent to an operating system. According to the 10th Edition of Merriam-Webster's Online Dictionary[6], accessed December 7, 2006, an operating system is "software that controls the operation of a computer and directs the processing of programs (as by assigning storage space in memory and controlling input and output functions)." In response to the above argument, the Examiner stated that, "the features on which the Applicant relies . . . are not recited in the rejected claims.[7] However, Applicant's arguments merely rely on the clear meaning of the term "operating system", which is recited in each of the pending claims. It is certainly not necessary that the claims recite

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[6] http://www.m-w.com/dictionary/operating%20system.
[7] Final Office Action mailed September 7, 2007, page 2.

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definitions for terms already having clear meanings as such recitation would not alter the scope
of the claims.

Stefanksy fails to disclose that microcontroller 224 operates any program other than the
microcontroller control program and also fails to disclose that the microcontroller control
program directs the processing of other programs. For example, Stefanksy fails to disclose that
programs other than the microcontroller control program even exist. In this manner, Stefanksy
fails to disclose an operating system and the Examiner's rejection of claim 1 should be
withdrawn.

Furthermore, in the Office Action with respect to claim 1, the Examiner acknowledged
that Stefanksy fails to disclose the feature of wherein the data disc stores an application program
run by the operating system as claimed, but that it would have been obvious to modify the disc
drive of Stefanksy to incorporate such a feature in view of Schneider. In support of this point,
the Examiner cited column 4, lines 5-16 of Schneider.

However, the portion of Schneider cited by the Examiner is related to an operating code
for micro-controller of a secure disc drive.[8] Importantly, this operating code is not an operating
system running an application program, and Schneider fails to consider that the micro-controller
may run an operating system running an application program. In this manner, Schneider fails to
overcome the deficiencies of Stefanksy as discussed above such that the subject matter of claim 1
would not have been obvious to one of ordinary skill in the art at the time of Applicant's
invention.

Glover and Durrett also fail to overcome the deficiencies of Stefanksy in view of
Schneider. For this reason, dependent claims 2-6, 25, 26 and 30-32 are allowable for at least the
reasons independent claim 1 is allowable. Furthermore, the dependent claims include additional
features that would not have been obvious to one of ordinary skill in the art at the time of
Applicant's invention.

For example, with respect to claim 5, the Examiner cited Stefanksy as disclosing a three
and one half inch form factor. However, because Stefanksy fails to disclose each of the features
recited in claim 1, e.g., a CPU running an operating system, Stefanksy fails to teach one of
ordinary skill in the art that such combination of features can fit into a package as small as a three

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[8] Schneider, column 4, lines 5-16 and column 5, lines 20-23.

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and one half inch form factor. In fact, none of the applied references would have made it obvious ton one of ordinary skill in the art at the time of Applicant's invention that the combination of features recited in claim 1 could fit into a package as small as a three and one half inch form factor.

Applicant respectfully requests the Examiner withdraw the rejections to claims 2-6, 25, 26 and 30-32.

Claims 16, 17 and 28

As discussed previously with respect to claim 1, Stefanksy in view of Schneider fail to teach or suggest a processor running an operating system running an application program as claimed. Similar features of a memory mounted on the PCB storing an application program, wherein the application program is run by the operating system running in the CPU are recited in claim 16. Therefore, the cited references would not have made the subject matter claim 16 obvious to one of ordinary skill in the art at the time of Applicant's invention.

Dependent claims 17 and 28 are allowable for at least the reasons independent claim 16 is allowable. Applicant respectfully requests the Examiner withdraw the rejections to claims 16, 17 and 28.

Claims 18-22, 24 and 29

As discussed previously with respect to claim 1, Stefanksy in view of Schneider fail to teach or suggest a processor running an operating system running an application program stored on a data disc. Similar features of a memory mounted within the case, wherein the memory stores an operating system, and the central processing unit runs the operating system, wherein the operating system runs application software stored on the data disc are recited in claim 18. Therefore, the cited references would not have made the subject matter claim 18 obvious to one of ordinary skill in the art at the time of Applicant's invention.

Glover fails to overcome the deficiencies of Stefanksy in view of Schneider. For this reason, dependent claims 17 and 28 are allowable for at least the reasons independent claim 18 is allowable. Applicant respectfully requests the Examiner withdraw the rejections to claims 18-22, 24 and 29.

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For at least these reasons, the Examiner has failed to establish a prima facie case for non-patentability of Applicant's claims 1-6, 16-22, 24-26 and 28-32 under 35 U.S.C. 103(a). Withdrawal of this rejection is requested.

New Claim

Applicant has added claim 33 to the pending application. The applied references fail to disclose or suggest the inventions defined by Applicant's new claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed inventions. No new matter has been added by the claim 33.

CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Applicant does not acquiesce with any of the Examiner's current rejections or characterizations of the prior art, and reserves the right to further address such rejections and/or characterizations.

Please charge any additional fees or credit any overpayment to deposit account number 50-1778.
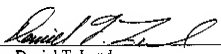
The Examiner is invited to telephone the below-signed attorney to discuss this application.

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October 31, 2007
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